

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** LAWRENCE GOETZ

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Appeal No. 97-0149  
Application 08/308,711<sup>1</sup>

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ON BRIEF

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Before MEISTER, McQUADE and CRAWFORD, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

***DECISION ON APPEAL***

Lawrence Goetz (the appellant) appeals from the final

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<sup>1</sup> Application for patent filed September 19, 1994.

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rejection of claims 1-5, the only claims present in the application. We affirm-in-part.

The appellant's invention pertains to a ballpoint pen which is designed to be received in a credit card receiving pocket of a pocket book. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

I. A ballpoint pen comprising an elongate, one-piece plastic body containing an elongate writing cartridge extending along a substantially central location thereof and, a plastic cap, the body being thin, and substantially rigid, having front, writing and rear longitudinal ends joined by respective, rearward diverging opposite side edges which diverge for a majority of an entire length of the body so as to provide a broad, flat, blade-like, hand engaging rear portion and the body tapering in thickness as it extends outward to opposite side and rear edges forming a narrow, peripheral insertion edge, the pen having an overall length, with the cap assembled, which is substantially equal to a conventional credit card, enabling the pen to fit snugly in a credit card receiving pocket of a pocket book.

The references relied on by the examiner are:

Perlmutter	Des. 195,924	Aug. 06, 1963
McKnight	3,994,605	Nov. 30, 1976
Mori	Des. 276,479	Nov. 27, 1984
Vinck	Des. 302,985	Aug. 22, 1989
Ellis	Des. 329,458	Sep. 15, 1992

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as

being unpatentable over Ellis in view of Mori, Perlmutter and Vinck.

Claims 3-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ellis in view of Mori, Perlmutter, Vinck and McKnight.

The examiner's rejections are explained on pages 2 and 3 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-8 of the brief, page 1 of the reply brief and pages 3-5 of the answer.

#### **OPINION**

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer. This review leads us to conclude that the prior art relied on by the examiner establishes the obviousness of the subject matter defined by claims 1 and 2 within the meaning of 35 U.S.C. § 103 and, accordingly, we will sustain the examiner's rejection of these claims. We will not, however, sustain the rejection of claims 3-5 under

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35 U.S.C. § 103.

Considering first the rejection of claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Ellis in view of Mori, Perlmutter and Vinck, the appellant in argument notes the deficiencies of the references individually and urges there is no suggestion to combine the teachings of the references in the manner proposed by the examiner. According to the appellant, the examiner has selected isolated teachings from the various references and has impermissibly relied upon the appellant's own teachings for a suggestion to combine.

We are unpersuaded by the appellant's arguments. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device (*see ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), it not necessary that the cited references or prior art specifically suggest making the combination (*B.F. Goodrich Co. V. Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and *In re Nilssen*, 851 F.2d 1401, 1403,

7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. **See *In re Young***, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, both Ellis and Mori depict ballpoint pens having elongated bodies (which can be considered to be "broad, flat and blade-like"), caps, thin bodies and generally diverging side edges. With respect to claim 2, Mori additionally teaches a rear end which is straight and a rectangular cap. On the other hand, Perlmutter teaches that it is well known in the ballpoint pen art to taper a flat, blade-like plastic body in thickness while Vinck

teaches that it is well known in the ballpoint pen art to size the pen and cap such that it is "substantially equal to a conventional credit card." Applying the test for obviousness<sup>2</sup>

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<sup>2</sup> The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the

as set forth in *In re Keller* at 642 F.2d 425, 208 USPQ 881, we are of the opinion that a combined consideration of the relied on references would have fairly suggested to one of ordinary skill in this art to provide the pen of either Ellis or Mori with (1) bodies which taper in thickness in view of the teachings of Perlmutter and (2) bodies and caps which are sized "substantially equal to a conventional credit card" in view of the teachings Vinck. As to the appellant's criticisms of the references individually, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

In view of the foregoing, we will sustain the rejection of

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structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

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claims 1 and 2 under 35 U.S.C. § 103 based on the combined teachings of Ellis, Mori, Perlmutter and Vinck.

Turning to the rejection of claims 3-5 under 35 U.S.C. § 103 as being unpatentable over Ellis in view of Mori, Perlmutter, Vinck and McKnight, the examiner has relied upon the teachings of McKnight for a "lobe." We must point out, however, a "lobe" is not what is being claimed. Rather, what is being claimed is that "rearward diverging opposite side edges" are further required to be "**straight** for a majority of their lengths" (emphasis ours) and have "one side edge having a greater divergence than the other side edge." We find nothing in McKnight which would fairly suggest such an arrangement. This being the case, we will not sustain the rejection of claims 3-5 under 35 U.S.C. § 103 based on the combined teachings of Ellis, Mori, Perlmutter, Vinck and McKnight.

In summary:

The rejection of claims 1 and 2 under 35 U.S.C. § 103 based on the combined teachings of Ellis, Mori, Perlmutter and Vinck is affirmed.

The rejection of claims 3-5 under 35 U.S.C. § 103 based

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on the combined teachings of Ellis, Mori, Perlmutter, Vinck  
and McKnight is reversed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

**AFFIRMED-IN-PART**

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	



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